24. (New) The soft count tracking system of claim 8, wherein the detachable soft count supervisor comprises one of a personal computer, a laptop computer, or a handheld data storage device.

25. (New) The method of claim 18, wherein the soft count supervisor is one of a personal computer, laptop computer, or handheld data storage device.

REMARKS

By this amendment, claims 8 and 18 have been amended and claims 24 and 25 added to more appropriately claim the invention. Claims 1-25 are currently pending.

In the Office Action, the Examiner rejected claims 1-23 under 35 U.S.C. § 251, claims 8-23 under 35 U.S.C. § 112, second paragraph, claims 8-17 under 35 U.S.C. § 112, first paragraph, and claims 18-23 under 35 U.S.C. § 112, first paragraph. Furthermore, the Examiner indicated that claims 1-23 were not rejected under prior art. Applicants traverse the Examiner's rejections for the following reasons.

The Examiner rejected claims 1-23 under 35 U.S.C. § 251 alleging an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue application is based. More specifically, the Examiner alleges that recapture exists because method claims were present in the originally filed application and were cancelled in response to an Office Action.

To determine whether an applicant surrendered particular subject matter, the Examiner must look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection. *See* M.P.E.P. § 1412.02 (8th ed. 2001). The patentee is free to acquire, through reissue, claims that are narrower in

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scope in all aspects than claims canceled from the original application to obtain a patent. *See* Id.

Applicants submit that independent claims 1-23, in general, and claims 18-23, in particular, are neither of the same scope as, or broader in scope than, the method claims canceled from the original application. Moreover, during prosecution of the method claims in the original application, Applicant's representative made no arguments in an effort to overcome a prior art rejection. Therefore, at least because claims 18-23 are sufficiently narrower than the method claims canceled in the original application, and no argument concerning the canceled method claims was made in the original application, the subject matter recited in claims 18-23 of the instant application was not surrendered in the original application. Applicants submit that the recapture rule does not apply and the Examiner's rejection of claims 1-23 under 35 U.S.C. § 251 should be withdrawn.

The Examiner rejected claims 8-23 under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner alleges that "capable of," as recited in the claims 8 and 18, does not particularly point out and distinctly claim the subject matter of the claims. By the above amendment, Applicants have replaced each instance of "capable of" in claims 8 and 18 with "for." As a result, Applicants submit that the Examiner's rejection of claims 8-23 under 35 U.S.C. § 112, second paragraph has been overcome and should be withdrawn.

The Examiner rejected claims 8-17 under 35 U.S.C. § 112, first paragraph alleging that the specification does not reasonably provide enablement for a computer

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capable of interrogating and extracting the information from the non-volatile storage memory of the storage mechanism and providing spread sheet data manipulation of the extracted information. The Examiner further alleges that a reasonable interpretation of the specification provides a computer that "interrogates and extracts **data** from the non-volatile storage memory of the storage mechanism and providing spread sheet data manipulation of the extracted **data**."

The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosure coupled with information known in the art without ***undue experimentation*** (emphasis added). *See* M.P.E.P. § 2164.01 (8th ed. 2001). Although not very clear from the rejection, the Examiner appears to make a distinction between "data," as used in the specification, and "information," as recited in the claim. Applicants point out, however, that "data" and "information" are used interchangeably throughout the specification. (e.g., col. 3, ll. 64 – col. 4, ll. 7; col. 4, ll. 44-45). For at least this reason, an ordinarily skilled artisan could make or use the invention from the disclosure coupled with information known in the art without ***undue experimentation***. Applicants submit, therefore, that the Examiner's rejection of claims 8-17 under 35 U.S.C. § 112, first paragraph should be withdrawn.

The Examiner rejected claims 18-23 under 35 U.S.C. § 112, first paragraph alleging that the specification does not reasonably provide enablement for the soft count supervisor including a computer capable of producing spread sheet data. In particular, the Examiner alleges that a fair reading of the originally filed specification would be interpreted by one of ordinary skill in the art to provide for the soft count supervisor

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being a specialty computer with specifically developed software that provides spread sheet type accounting of notes and coupons.

Independent claim 18 recites a combination of steps including, among other things, "communicating the performance information from the nonvolatile memory of the storage mechanism to a soft count supervisor for interrogating, extracting, and manipulating the performance information communicated from the nonvolatile memory of the storage mechanism." Because claim 18 does not recite "a computer capable of producing spread sheet data," which forms the basis of the Examiner's rejection, Applicants submit that the Examiner's rejection of claims 18-23 under 35 U.S.C. § 112, first paragraph is not applicable and should be withdrawn.

The Examiner indicated that a supplemental declaration should be filed to cover the amendment filed on April 25, 2002. Applicants hereby acknowledge the Examiner's request and will provide the supplemental declaration upon the allowance of all pending claims.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-25 in condition for allowance. Applicants submit that the proposed amendments of claims 8 and 18, and the addition of claims 24 and 25 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against

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Applicant's invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: November 12, 2002

By: _____
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